

REMARKS

Claims 17-116 are pending. Claims 29, 37, 48, 54, 60, 75, 82, 91, 100, and 115 are withdrawn.

Claims 17, 31, 39, 50, 56, 84, 93, 102, and 110 have been amended to recite that the claimed proteins stimulate the proliferation of myeloid cells. Support is found in the specification *inter alia* at page 1, lines 10-12; page 5, lines 15-19; page 22, lines 13-17; page 26, lines 14-27; and page 28, line 23 through page 30, line 5. Thus, no new matter has been introduced by these amendments.

Claim 93 has been amended to add the phrase "wherein said fragment is at least 30 amino acids in length". This phrase was part of claim 93 as originally filed in the First Preliminary Amendment of July 9, 2001, but was inadvertently omitted when claim 93 was rewritten in Applicants' amendment filed April 14, 2003. Thus, the present amendment merely restores language which was originally in claim 93, and no new matter has been introduced.

Rejections Under 35 U.S.C. § 112, First Paragraph

Availability of the Deposited cDNA Clone.

Claims 17-28, 30-36, 38-47, 49-53, 55-59, 61-74, 76-81, 83-90, and 92-99 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking written description because insufficient assurance has been provided that all of the conditions of 37 CFR sections 1.801 through 1.809 have been met for the deposited cDNA clone. *See* Paper No. 13 at page 4. The rejection is respectfully traversed.

Initially, it is noted that the listing of rejected claims, as cited in the paragraph

above and appearing in the Office Action at item number 5, includes claims which are not directed to the deposited cDNA clone, *e.g.*, claims 17-28, 30-36, 38, 62-74, 76-81, 83-90, and 92. The rejection, as it applies to those claims, is moot because the claims do not recite any deposited clone. The claims which are directed to the deposited clone are 39-47, 49-53, 55-59, 61, 93-99, 101-107, 109-114, and 116. Thus, Applicants assume that this rejection actually was intended to apply to claims 39-47, 49-53, 55-59, 61, 93-99, 101-107, 109-114, and 116, and Applicants' remarks below are relevant to these claims.

While Applicants believe that the instant specification provides adequate assurances that the terms of the Budapest Treaty have been met, a Statement Concerning the Deposited cDNA Clone, signed by Applicants' attorney, is enclosed. In view of the enclosed Statement regarding availability of the deposited clone, Applicants believe the Examiner's concerns have been fully addressed. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

With regard to the description of the deposited cDNA clone in the specification, the Examiner states, "Amendment of the specification to disclose the date of the deposit and the complete name and address of the depository is required." *See* Paper No. 13 at page 5, lines 9-10. Applicants respectfully point out that the date of deposit was disclosed in the specification as originally filed in the paragraph beginning at page 5, line 2. Furthermore, the current address of the depository was added by amendment to that same paragraph in the Second Preliminary Amendment filed July 9, 2001. Thus, the specification is believed to be in compliance with the disclosure requirements for the deposited cDNA clone.

Activity of Claimed Variant Proteins

Claims 17-28, 30-36, 38-47, 49-53, 55-59, 61-74, 76-81, 83-90, and 92-99 are rejected as lacking written description because the claims are allegedly "drawn to a large variable genus of polypeptides with unknown activity or inactive variants." Paper No. 13 at page 5, lines 15-17. Applicants disagree and traverse.

Initially, Applicants point out that the Office Action Summary also includes claims 101-107, 109-114, and 116 as rejected in addition to the above cited rejected claims. Applicants assume that these claims were intended to be included in the set of rejected claims, and the arguments set forth below apply to claims 101-107, 109-114, and 116 as well as the claims listed in the rejection at page 3, item number 5 of Paper No. 13. Furthermore, the Office Action describes this rejection using both the language of a written description rejection ("[T]he specification fails to sufficiently describe the claimed invention in such full, clear, concise and exact terms that a skilled artisan would recognize that applicants were in possession of the invention as claimed"; *see* Paper No. 13 at page 6, lines 1-3) and the language of an enablement rejection ("In order to make an accurate assessment of the modifications encompassed by these claims and to determine the function of the encoded protein fragment would require undue experimentation"; *see* Paper No. 13 at page 6, lines 10-13). However, the present claim amendments and remarks pertain to and overcome either ground for rejection.

Applicants assert that the disclosure includes adequate information to provide a "measureable end point" by which to assess modifications allowed by the claims. Nevertheless, in the interest of furthering prosecution, each of the independent claims has been amended to specify that the claimed polypeptides stimulate the proliferation of myeloid cells. Applicants submit that this specifies a clearly measureable endpoint and

also demonstrates that Applicants were in possession of the claimed invention. Therefore, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance. An early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: September 12, 2001

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Olsen, et al.

Serial No.: 09/899,917

Art Unit: 1653

Filed: July 9, 2001

Examiner: H. Robinson

For: Human Oncogene Induced
Secreted Protein I

Docket No.: PF306D1

Statement Concerning the Deposited cDNA Clone

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned attorney of record hereby states:

1. A plasmid containing human cDNA encoding a human oncogene induced secreted protein I polypeptide was deposited under the terms of the Budapest Treaty on December 16, 1996 at the American Type Culture Collection (ATCC), Patent Depository, 10801 University Boulevard, Manassas, Virginia 20110-2209 (current address), and given accession number 97825.

2. Assurance is hereby given that: (1) the deposit was made under terms of the Budapest Treaty; (2) except for the limitations allowed by 37 C.F.R. § 1.808(b), all restrictions on the availability to the public of the deposit will be irrevocably removed upon the granting of a patent from the captioned application; (3) the deposit has been made under conditions such that access to the material will be available during the pendency of the captioned patent application to one determined by the Commissioner; and (4) the deposit will be maintained with the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposit, and in any case, for a period of at least thirty years after the date of deposit or for the enforceable life of the patent, whichever period is longer.

Respectfully submitted

Date: 2 October 2003


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